REMARKS

With entry of the present amendment, claims 24, 25, 27-34, 38-42, 51-55, 59-61, 67, 68, 71-77 and 83-108 are pending. Claims 24, 25, 27-34, 38-42, 51-55, 59 and 90 are allowed. Claims 60, 61, 67, 84, 107 and 108 are amended as shown above.

Claims 60, 61, 84, 107 and 108 are amended to replace the trademark pluronic F68 with poloxamer 188.

Claim 67 is amended as the parenthesis in formula (I) were incorrect. The formula was corrected to read as it appears on paragraph [0056] , page 15, of the specification.

No new matter is believed to be presented by the foregoing amendments.

Entry of this amendment and reconsideration of the claims, as amended and in view of the following remarks, is requested.

The Section 112 Rejections

Claims 60, 61, 84, 107 and 108 are newly rejected under 35 USC § 112 as being indefinite for including the trademark/trade name "Pluronic F68" in the claims. As suggested by the Examiner, applicant has amended the claims to substitute the generic term "poloxamer 188," for the trademark. This rejection is thus overcome.

The Section 102 Rejection

Claims 67-68, 71, 73, 75, 77, 83, 85, 86, 91-101, 104 and 106 are again rejected under 35 USC § 102(e) as being anticipated by US Pat. No. 6,583,272 B1 ("Bailon" or "the '272 patent"). This rejection is traversed.

Applicants previously sought to overcome this rejection by filing a Rule 132 declaration of Dr. Papadimitriou, the inventor of the above-captioned application, affirming that he is the sole inventor of the formulations disclosed and not claimed in the Bailon '272 patent and as such, the Bailon '272 patent is not prior art. In the Office Actin mailed December 23, 2005, the Patent Office dismissed the Papadimitriou declaration as being improper because there was no common inventor between the instant application and the '272 patent. In the current rejection, the Patent Office concurs that a Rule 132 declaration is indeed appropriate under the fact pattern herein presented, however, the declaration is now deemed defective as not "providing supported documents" indicating that the instantly claimed compositions were first disclosed to the inventor of the '272 patent by the inventor of the instant application and that the instantly claimed compositions were invented prior to the filing date of the '272 patent. To expedite the allowance of this case, applicant is submitting herewith the requested declaration of Dr. Papadimitriou with supporting documents as well as a declaration of Pascal Bailon, the inventor of the '272 patent, affirming that the formulations disclosed and not claimed in the '272 patent originated with the inventor of the instant application and are not a part of the Bailon invention that is claimed in the '272 patent. Notwithstanding the fact that applicant is providing these declarations, applicant submits the requested declarations are unnecessary to patentability of the claimed invention as the facts stated in the declarations are already otherwise of record and no declarations should be necessary at all.

Consistent with the enclosed declarations of Dr. Papadimitriou and Mr. Bailon, the current record already reflects the following facts:

(1) The four 1999 provisional applications from which the Bailon '272 patent claims priority did not contain a disclosure of any formulation, and certainly did not contain Example 8 or Table 3.

(2) The European application from which the instant application claims priority (Application No. 00110355.5) was filed on May 15, 2000. A copy of this European

application was provided by applicant to the U.S. Patent Office on August 23, 2001, and was received by the Patent Office on August 27, 2001.

(3) Subsequent to the filing of the European priority application for the instant case, on June 27, 2000, the US non-provisional application on which the Bailon '272 patent is based was filed (USSN 09/604,938). The first time Example 8 and Table 3 appeared in the chain of applications leading to the Bailon '272 patent was in the '938 application filed in June 2000.

(4) Example 10 of European Application No. 00110355.5 is almost verbatim what became Example 8 of the Bailon '272 patent, and Table 3 in the 00110355.5 application is the same as Table 3 in the '272 patent.

Based on the foregoing facts already of evidence in the record, the European priority application on which the instant application is based predates the appearance of Example 8 in the chain of applications leading to the Bailon '272 patent. As such, Example 8 of the '272 patent is not prior art against the instant application and the Section 102 rejection should be withdrawn. Moreover, both Dr. Papadimitriou and Mr. Bailon, through their declarations, confirm that Dr. Papadimitriou conducted the formulation work claimed in the instant application using one of Mr. Bailon's pegylated conjugates and that Mr. Bailon's invention was directed to pegylated conjugates and not formulations.

For the reasons already of record and as further detailed above and confirmed in the accompanying declarations, the disclosure in the Bailon '272 patent of formulations is not prior art to the instant application and the Section 102(e) rejection should be withdrawn.

The Section 103 Rejection

Claims 72, 74, 76, 84, 87-89, 102, 103, 105, 107 and 108 are rejected under 35 USC § 103(a) as being unpatentable over the Bailon '272 patent in view of WO

00/51629 (Sato, the English language equivalent of which is US Patent 6,908,610). This rejection is also traversed.

For the reasons provided above with respect to the Section 102 rejection, the effective date of the Bailon '272 disclosure of Example 8 is June 27, 2000, not July 2, 1999. As such, the Bailon '272 patent is not prior art against the currently claimed formulations. Sato is also not prior art. The Sato PCT application was filed on February 29, 2000, which is before the recent change in law that went into effect for PCT applications filed in English after November 29, 2000. As such, the effective prior art date of the Sato US '610 patent is August 30, 2001. Moreover, even the Sato PCT publication date of September 8, 2000 is after applicant's priority date of May 15, 2000. Thus, neither '272 patent nor Sato are proper references against the instantly claimed formulations and this rejection should be withdrawn.

CONCLUSION

The foregoing amendment is fully responsive to the Office Action issued April 13, 2006. Applicant submits that claims 60, 61, 67-68, 71-77, 83-89 and 91-108 as amended, are now also allowable. Early and favorable consideration of this amendment and these claims is earnestly solicited.

If the Examiner believes there are other issues that can be resolved by telephone interview, or that there are any informalities remaining in the application which may be corrected by Examiner's Amendment, a telephone call to the undersigned attorney is respectfully solicited.

Applicants believe that no fee is due with this communication. However, should the Patent Office determine that a fee is owed, or a credit is due to applicant, the Patent Office is hereby authorized to charge any required fees, including any extension of time and/or excess claim fees, or credit any overpayment, to applicant's Deposit Account 08-2525 as appropriate.

Respectfully submitted,

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Attachments

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